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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,137	06/26/2001	Paul R. Stonikas	BLP 128.1	4376

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EXAMINER	
NI, SUHAN	
ART UNIT	**PAPER NUMBER**
2646	

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/892,137	STONIKAS ET AL.	
	Examiner	Art Unit	
	Suhan Ni	2646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 September 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-34, 104-117 and 133-141* is/are pending in the application.

4a) Of the above claim(s) *133-141* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-34 and 104-117* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This communication is responsive to the amendment dated 09/30/2005.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 21-34 and 104-117 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of U.S. Patent No. 6,393,130. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-44 of U.S. Patent No. 6,393,130 are similar in scope to claims 21-34 and 104-117 of this application with obvious wording variations.

3. Claims 21-34 and 104-117 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,584,207. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-28 of U.S. Patent No. 6,584,207 are similar in scope to claims 21-34 and 104-117 of this application with obvious wording variations.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 21-27, 29, 32-34, 104-110, 112 and 115-117 are rejected under 35 U.S.C. 102(b) as being anticipated by Aceti et al. (U. S. Pat. - 5,530,763).

Regarding claims 21-22 and 104-105, Aceti et al. disclose a hearing aid comprising: a deformable skin (2) bounding an internal region (Fig. 1); and at least one spine (5) extending axially along an interior surface of the skin, which is attached thereto sufficiently so as to provide insertion rigidity when inserted into the user's ear canal as claimed.

Regarding claims 23-24 and 106-107, Aceti et al. further disclose the hearing aid, wherein further comprises an output transducer (41) and a vent (Fig. 3), and the skin and spine, but not an output transducer, are distorted on insertion into the ear canal (col. 5, lines 27-35) as claimed.

Regarding claims 25-27, 32-33, 108-110 and 115-116, Aceti et al. further disclose the hearing aid, wherein a deformable matrix (1) applying expansive forces to the skin.

Regarding claims 29 and 112, Aceti et al. further disclose the hearing aid, wherein an audio output transducer (41) surrounded, at least in part, by a compressible matrix (Figs. 1-2) as claimed.

Regarding claims 34 and 117, Aceti et al. further disclose the hearing aid, wherein a faceplate (3) attached to the skin.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 28, 30-31, 111 and 113-114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aceti et al. (U. S. Pat. - 5,530,763).

Regarding claims 28 and 111, Aceti et al. do not clearly teach a plurality of ribs as claimed. Since providing a plurality of ribs formed on an exterior periphery of a hearing aid skin is very well known in the art, it therefore would have been obvious to one skilled in the art at the time the invention was made to provide a plurality of suitable ribs formed on an exterior periphery of the skin of the hearing aid as a cerumen trapper, in order to protect the hearing aid.

Regarding claims 30-31 and 113-114, Aceti et al. do not clearly teach the matrix comprises at least one of open cell foam, closed cell foam, and a fabric as claimed. Since providing a desirable otoplastic material for the hearing aid housing is very well known in the art, it therefore would have been obvious to one skilled in the art at the time the invention was

made to provide a suitable otoplastic material, such as at least one of an open cell foam, a closed cell foam, and a fabric for the hearing aid, in order to provide more comfort to users.

Response to Amendment

6. Regarding the newly submitted claims 133-141 directed to an invention that is independent or distinct from the invention originally claimed, which contains newly introduced limitations, such as "**a continuously deformable matrix in the region wherein the matrix applies expansive forces to the skin**". With all the limitations added, which clearly are not from the elected invention originally claimed (claims **21-34** and **104-117**).

Since applicants have received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims **133-141** are not original presented and elected and are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

7. Applicant's arguments dated 09/30/2005 have been fully considered, but they are not deemed to be persuasive.

Regarding the only two independent claims 21 and 104, the applicants state: "Thus, the fact that in the structure of Aebi et al. the diaphragm 2 is not attached to the connecting element 5 means that it cannot anticipate claims 21-27, 29, 32-34, 104-1 10, 112 and 115-117 as argued by the Examiner" (page 8).

The examiner respectfully disagrees with the applicant, and the cited reference (U. S. Pat. - 5,530,763) does clearly show, especially in Figure 2, that the diaphragm (2) is attached to the

connecting element (spine) 5, through other structures, such as an extension part (4) of the spine 5, or filler material under the skin.

Regarding claims 28, 30-31, 111 and 113-114, the applicants argue no motivation to combine the references. It is not necessary that the references actually suggest, expressly or in so many words the changes or improvements that applicants have made. The test for combining references is what the references as whole would have suggested to one of ordinary skilled in the art. **In re Sheckler, 168 USPQ 716 (CCPA 1971); In re Mlaughlin 170 USPQ 209 (CCPA 1971); In re Young 159 USPQ 715 (CCPA 1968).**

Conclusion

8. **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

9. Any response to this final action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(703) 308-9051, (for formal communications; please mark "EXPEDITED PROCEDURE"), or

(703) 305-9508, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Suhan Ni** whose telephone number is **(571)-272-7505**, and the number for fax machine is **(571)-273-7505**. The examiner can normally be reached on Monday through Thursday from 10:00 am to 8:00 pm. If it is necessary, the examiner's supervisor, **Sinh N. Tran**, can be reached at **(571)-272-7564**.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (**PAIR**) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov/. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is **(571)-272-2600**, or please see http://www.uspto.gov/web/info/2600.

SUHAN NI
PRIMARY EXAMINER

December 17, 2005